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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,303	01/14/2002	Eric K. Manning		7450

7590

01/14/2005

Eric K. Manning
206 W. Tenth St.
Dallas, TX 75208

EXAMINER

DAHBOUR, FADI H

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047,303

Applicant(s)

MANNING, ERIC K.

Examiner

Fadi H. Dahbour

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-47 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Incomplete Response to Restriction

1. The Examiner acknowledges Applicant's response to the restriction mailed on 09/30/04. However, Applicant's response to the restriction is incomplete. A complete response is required, in response to the restriction (re-printed below). Any questions can be directed to Fadi Dahbour, whose telephone number is 571-272-4792.

Election/Restriction

2. This application contains claims directed to the following patentably distinct species of the claimed invention. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-2, 18-24, 27-28, 36-42, 45-47 are generic:

Group 1: claim 3, wherein the penis extension is porous.

Group 2: claim 4, wherein the penis extension is non-porous.

Applicant is further required under 35 U.S.C. 121 to elect a single disclosed species from the following patentably distinct species of the claimed invention, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-2, 18-24, 27-28, 36-42, 45-47 are generic:

Group 3: claim 5, wherein the spermicide is water activated.

Group 4: claim 6, wherein the spermicide is chemically activated.

Group 5: claim 7, wherein the spermicide maybe time released.

Applicant is further required under 35 U.S.C. 121 to elect a single disclosed species from the following patentably distinct species of the claimed invention, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-2, 18-24, 27-28, 36-42, 45-47 are generic:

Group 6: claim 8, wherein the medication is water activated.

Group 7: claim 9, wherein the medication is chemically activated.

Group 8: claim 10 wherein the medication maybe time released.

Applicant is further required under 35 U.S.C. 121 to elect a single disclosed species from the following patentably distinct species of the claimed invention, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-2, 18-24, 27-28, 36-42, 45-47 are generic:

Group 9: claim 11, wherein the penis extension absorbs sperm.

Group 10: claim 12, wherein the penis extension traps sperm.

Group 11: claim 13, wherein the penis extension eliminates sperm.

Applicant is further required under 35 U.S.C. 121 to elect a single disclosed species from the following patentably distinct species of the claimed invention, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-2, 18-24, 27-28, 36-42, 45-47 are generic:

Group 12: claim 14, wherein the penis extension is bonded to the condom by glue.

Group 13: claim 15, wherein the penis extension is bonded to the condom by adhesive.

Applicant is further required under 35 U.S.C. 121 to elect a single disclosed species from the following patentably distinct species of the claimed invention, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-2, 18-24, 27-28, 36-42, 45-47 are generic:

Group 14: claim 16, wherein the penis extension maybe bonded to the penis by glue.

Group 15: claim 17, wherein the penis extension maybe bonded to the penis by adhesive.

Applicant is further required under 35 U.S.C. 121 to elect a single disclosed species from the following patentably distinct species of the claimed invention, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-2, 18-24, 27-28, 36-42, 45-47 are generic:

Group 16: claim 25, wherein the penis extension maybe positioned throughout the inner lined wall.

Group 17: claim 26, wherein the penis extension maybe positioned throughout the outer lined wall.

Applicant is further required under 35 U.S.C. 121 to elect a single disclosed species from the following patentably distinct species of the claimed invention, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-2, 18-24, 27-28, 36-42, 45-47 are generic:

Group 18: claim 29, wherein the adhesive is bactericidal.

Group 19: claim 30, wherein the adhesive is mycocidal.

Group 20: claim 31, wherein the adhesive is spermicidal.

Group 21: claim 32, wherein the adhesive is viralcidal.

Group 22: claim 33, wherein the adhesive is hypoallergenic.

Applicant is further required under 35 U.S.C. 121 to elect a single disclosed species from the following patentably distinct species of the claimed invention, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-2, 18-24, 27-28, 36-42, 45-47 are generic:

Group 23: claim 34, wherein the adhesive is manufactured from totally organic substances.

Group 24: claim 35, wherein the adhesive is manufactured from medical grade material.

Applicant is further required under 35 U.S.C. 121 to elect a single disclosed species from the following patentably distinct species of the claimed invention, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-2, 18-24, 27-28, 36-42, 45-47 are generic:

Group 25: claim 43, wherein the safety string is bonded to the penis extension by glue.

Group 26: claim 44, wherein the safety string is bonded to the penis extension by adhesive.

3. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadi H. Dahbour whose telephone number is 571-272-4792. The examiner can normally be reached on M-F, 9am-5:30pm est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett, can be reached on (571) 272-4791.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Fadi H. Dahbour
Examiner
Art Unit 3743